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DATE: August 4, 2008

TO: Examiner Michael A. Marcheschi
Group Art Unit 1793

PHONE #: 571-272-1374

FAX #: 571-273-8300

Application No.: 09/136,483
Applicant: Kumar et al.
Due Date: August 4, 2008

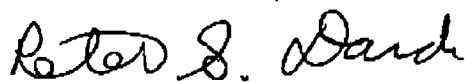
OUR REF.: 2950.25US01

FROM: Peter S. Dardi, Ph.D.
PHONE #: 404-949-5730

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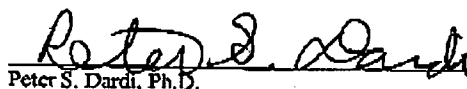
(1). Reply Brief.

Respectfully submitted,

Peter S. Dardi, Ph.D.
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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Attorney Docket No.: 2950.25US01

Kumar et al.

Confirmation No.: 1810

Application No.: 09/136,483

Examiner: Michael A. Marcheschi

Filed: August 19, 1998

Group Art Unit: 1793

For: ALUMINUM OXIDE PARTICLES

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

In response to the Examiner's Answer dated June 4, 2008, Appellant submits the following additional comments. Appellant addresses only some of the clear errors of law and errors of facts presented in the Examiner's Answer.

Please grant any extension of time necessary for entry; charge any fee due to Deposit Account No. 50-3863.

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August 4, 2008
Date

Peter S. Dardi
Peter S. Dardi, Ph.D.

Application No. 09/136,483

1. Error of Law With Respect to the Relevance of Process Limitations

On page 7 of the Examiner's Answer it is stated that "At most, appellants argue that they have shown un-refuted evidence that the Rostoker patent does not teach a process for producing the claimed particle collections. **This is not persuasive because appellants arguments are merely directed to process limitations, however, the claims are directed to a composition.**" This statement reflects clear legal error. It is very long and well established that the prior art only makes a composition of matter unpatentable to the extent that the prior art presents a method for producing the composition of matter. If the prior art does not place the claimed subject matter in the hands of the public, then the composition of matter remains patentable.

This was well established many years ago.

To the extent that anyone may draw an inference from the Von Bramer case that the mere printed conception or the mere printed contemplation which constitutes the designation of a 'compound' is sufficient to show that such a compound is old, regardless of whether the compound is involved in a 35 U.S.C. 102 or 35 U.S.C. 103 rejection, we totally disagree. ... We think, rather, that the true test of any prior art relied upon to show or suggest that a chemical compound is old, is whether the prior art is such as to place the disclosed 'compound' in the possession of the public. In re Brown, 141 USPQ 245, 248-49 (CCPA 1964) (emphasis in original) (citations omitted).

Further case law is cited in Appellant's main brief. However, even more importantly, the Federal Circuit acknowledged this well established legal principle in *In re Kumar*, which represents the binding law of the case. The present appeal is on remand from the Federal Circuit. Unfortunately, the Patent Office has not been able to apply the correct law to the present case.

2. Error of Law With Respect to Validity of Rostoker Patent

On page 8 of the Examiner's Answer, the validity of the Rostoker patent is discussed in the context of the presumption of validity. Appellant established before the Federal Circuit that the validity of Rostoker is completely irrelevant to the present analysis. This is the law of the

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case. The Patent Office's inability to grasp this legal concept is indescribably frustrating. It has also resulted in a shocking waste of Applicant's limited resources. The only issue of relevance is whether or not the cited references provide a reasonable expectation of practicing Appellant's claimed invention, which involves the production of the claimed composition of matter.

The Examiner cites *In re Sasse* for the proposition that "affidavits or declarations attacking the operability of a patent cited as a reference must rebut the presumption of operability by a preponderance of the evidence." While this legal proposition is of relevance, the Examiner has not applied this reasonably due to a continued misunderstanding of the relevance of the presumption of validity of Rostoker. With all due respect, Appellant has presented overwhelming evidence regarding the factual presentation of Rostoker that has been countered by nothing appropriate on the part of the Examiner. Appellant has presented evidence beyond a reasonable doubt, as summarized in the following factual rebuttal.

3. Errors of Fact With Respect to the Distribution in Rostoker

With respect to the declaration of Professor Singh, the Examiner's Answer on page 8 states that the "Declaration criticizes one possible definition of Q, as defined in the reference and there has been no showing of a preponderance of the evidence that the value of Q cannot be determined by the disclosed method." The issue is what does the reference teach to a person of ordinary skill in the art. The Examiner and the Examiner's supervisor have not established that they are persons of ordinary skill in the art. If they provided affidavit evidence, then Appellant could work to refute that evidence. All they have provided is some attempt to rewrite the Rostoker patent to make sense. The only basis for their exercise is that the Rostoker patent is presumed valid. That is simply not a legally valid justification for rewriting the Rostoker patent to make sense in the context of analyzing the validity of Appellant's claims. Appellant has provided a sworn Declaration by an expert that the distribution in Rostoker cannot be clearly

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evaluated. Examiner arguments with absolutely no documentary evidence cannot overcome sworn declaration evidence by an expert without clear error on the part of the expert, which does not exist here.

4. Errors of Fact With Respect to the Teaching of Rostoker With Respect to Appellant's Compositions of Matter

It is the burden of production of the Examiner to establish unpatentability by a preponderance of the evidence. The Examiner's Answer on page 7 describes Rostoker as teaching the method of Siegel et al. "as showing a known possible method." (Emphasis in original.) It is unbelievable for the Examiner to state that "Rostoker et al. does not limit the method to the Siegel et al. method, as apparently argued by the appellants." Appellant has been looking for years for any other prior art approach to produce these claimed compositions of matter without relying on the Siegel method as the only possible method of production. We have produced two expert Declarations relating to non-Siegel methods. Does that make any sense whatsoever if Appellant is arguing that Rostoker is limited to the Siegel method? Appellant has talked with experts within and outside the company. If the Examiner is keeping some method secret, please share it so that we can address this and move on.

Appellant has supplied two Declarations and documentary evidence that support the fact that Rostoker does not enable the production of Appellant's claimed composition of matter. The Patent Office has presented absolutely no legally or factually relevant counter evidence. This remains true.

The Examiner's Answer states that the Kambe Declaration is not convincing "because Rostoker et al. teach alumina particles having the sizes within the claimed range and therefore a prima facie case of obviousness is established." Since the particles have the same size and distribution, they must have been produced by some method." (Emphasis in original.)

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Assuming incorrectly for arguments sake only that Rostoker does teach the same size and distribution, Rostoker does not teach any real material. There are no working examples in Rostoker. With all due respect, it is nonsensical to say they must have been produced by some method because they did not produce any material, not even the method of Siegel et al. If no material is produced, no method is needed.

With all due respect, the Rostoker patent provides no guidance whatsoever on how to produce the compositions of matter in Appellant's claims. Appellant has provided evidence beyond a reasonable doubt that such a method was not known in the prior art. The Examiner and the Examiner's supervisor have not been able to provide any guidance whatsoever, even when directly asked, what further evidence would be convincing. Appellant has provided all of the evidence that they could think of.

The Examiner's Answer states on page 11 that the "examiner is not denying that Dr. Singh, Dr. Kambe and Dr. Li are experts in the field, the examiner has simply rebutted the declarations and appellants have not presented any clear and convincing evidence showing the Examiner is incorrect in his rebuttal." The only rebuttal from the Examiner seems to be the incorrect legal argument that Rostoker must be operable and the incorrect factual argument that Rostoker must have made the material somehow when they did not make anything. On page 13 of the Examiner's Answer it is stated that the "fact that the examples (of Rostoker) do not say how to obtain the particles within the taught ranges does not establish that method for making the particles is unknown because they must have been made, thus does not overcome the rejection. A reference does not require specific disclosure of what is known to one of ordinary skill in the art." But Appellants have established that Experts do not know this. Therefore, clearly a person of ordinary skill in the art does not know this method. And nothing was made by Rostoker, so it is simply nonsensical to say that the materials "must have been made" since nothing was made. With all due respect, the Patent Office's position does not make any sense legally or factually.

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On page 14, the Examiner's Answer states that they have "presented clear evidence that the claimed particles are known, thus refuting appellant's evidence." What does known mean? The Patent Office has not pointed to any known method in the prior art to produce the claimed compositions of matter. The Examiner's Answer displays a clear, utter failure of the Patent Office to meet their burden of production to establish unpatentability by a preponderance of the evidence.

CONCLUSIONS

Rostoker does not teach alumina particles with the claimed narrow particle size distribution. Furthermore, the combined teachings of the cited references along with the known processes within the skill in the art do not teach how to produce the compositions of matter claimed by Applicant's. The Examiner has failed to establish *prima facie* unpatentability, and to the extent that *prima facie* unpatentability has been established, Appellant has rebutted the Patent Office position beyond a reasonable doubt. The Examiner has fallen shocking short of meeting their burden of establishing unpatentability of the subject matter by a preponderance of the evidence.

Respectfully submitted,



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